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First named inventor	KEMBEL et al.
Examiner Name	C. T. Nguyen
Confirmation Number	1656
Art Unit	2176
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ENCLOSURES (Check all that apply)

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☐ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/Declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Reply to Missing Parts/Incomplete Application
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Remarks: Refiling Appeal Brief per Notice of Non-Compliance mailed 6/22/2007. All other appeal-related documents filed 5/4/2007 are unaffected by this resubmission.

SIGNATURE OF APPLICANT, ATTORNEY OR AGENT REQUIRED

Signature:	Jonathan C Small	Telephone: 650-941-4470
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AF/2176

PATENT APPLICATION
Attorney Docket No. **10351-0006**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: KEMBEL et al.	)	Confirmation No.: 1656
	)	
Appl. No.: 09/558,923	)	Art Unit: 2176
	)	
Filed: 04/26/2000	)	Examiner: C. T. Nguyen

Title: Apparatus and Method for Dynamically Coordinating the Delivery of Computer Readable Media

United States Patent and Trademark Office
Commissioner for Patents
Washington, D.C. 20231

APPEAL BRIEF
[Refiling per Notification of Non-Compliance Mailed 6/22/2007]

Sir:

Applicant respectfully submits this Appeal Brief in the appeal from the Office Action dated December 5, 2006, (hereinafter referred to as the "Office Action") in which all claims were finally rejected. Applicant filed its Notice of Appeal on April 5, 2007.

Table of Contents

1. Real Party in Interest

The real party in interest is Mainstream Scientific, LLC, the assignee of all right and interest in and to the present application and any patent issuing thereon.

2. Related Appeals and Interferences

The subject matter of this appeal relates to the subject matter of application 09/558,925, titled "Apparatus and Method for Interacting with Internet Content", assigned to the same assignee as the present case, which case stands finally rejected and for which an appeal brief was filed on March 5, 2007.

3. Status of the Claims

Claims 51-56 are pending in the present application. Claims 51-56 (all) were finally rejected in the Office Action. Presently, claims 51-56 (all) are rejected. Claims 51-56 (all) are appealed.

4. Status of Amendments

No amendment after Final Rejection has been submitted. All amendments have been entered.

5. Summary of Claimed Subject Matter

The present invention is directed to a method of obtaining internet content for use by a user's computing device. The method is unique in that the content obtained comprises:

1) instructions for presenting on the computing device a frame (a "NIM" in the language of the specification) within which internet content may be displayed independent of a web browser program, and

2) an address from which the content to be rendered in the frame may be obtained.

The information further includes controls specific to the particular frame. In addition, the functionality and appearance of the frame is specified by the obtained information. That is, the obtained information may include code and data which result in the display device rendering a specific frame design (and operation) for specific content. Furthermore, the information may include instructions for invoking a process, resident on the display device, the results of which are displayed within the frame.

Critically, while the content is capable of being read by an internet browser application (hence "Internet content"), it is actually rendered independent of a web browser program. In terms of the specification, this limitations is illustrated for example

at page 33, lines 17-18, at which we find "[t]he definition of a NIM thus includes everything that is needed for the NIM to be rendered and filled with Internet content." That is, nothing from or associated with a web browser application (or any other application) is needed in order to render the content of a NIM in its frame.

The motivation to develop a method to obtain information permitting internet content to be rendered without dependence on a web browser is at least two-fold. First, this independence from a web browser application frees the content provider from the constraints on presentation of content imposed by traditional web browser software and browser user interfaces, such as rectangular windows, limited controls, etc. Second, the independence from a web browser program means that components may be rendered using fewer computing resources, on a greater variety of platforms, and may operate without requiring the presence of any particular vendor's web browser application, indeed without requiring the presence of any web browser application at all.

6. Grounds of Rejection to be Reviewed on Appeal

All claims of the present application were rejected as being anticipated by a single reference, U.S. Patent 6,297,819 (Furst), under 35 U.S.C. 102. Thus, there is a single overarching issue to be reviewed on appeal:

Does U.S. Patent 6,297,819 (Furst) teach each and every limitation of claims 51-56, and thus anticipates those claims under 35 U.S.C. 102?

7. Argument

A. *Introduction*

As a brief introduction to appellant's arguments, it should be noted that claim 51, the sole independent claim pending in this case, includes the step of retrieving and transmitting to a computing device information specifically designed for displaying content independent of a browser program. The information includes instructions usable by a computing device to present a frame and controls specifically designed to display that specific content. The information essentially defines the appearance and operation of the frame. The information also includes an address from which said content can be retrieved. Thus, the method obtains a definition of a frame for rendering internet content independent of a web browser application as well as the address from which such content is obtained. By simply requesting the browser-independent display window, operational elements (i.e., frame definition and controls) required to render and populate (i.e., the content address) that window may be assembled and transmitted to the computing device.

This may be contrasted with the teachings of Furst. In making this contrast, appellant first discusses what Furst teaches, then how Furst fails to teach each and every element of the presently claimed invention.

Furst is perhaps best and most succinctly summarized by its abstract, which states that the reference teaches:

> [s]ystems, methods, and apparatus (including computer program apparatus) for a browser-aware application delivery system. The System provides World Wide Web browser extensions based on server processes rather than on plug-in program modules loaded and installed on a user's machine. The system operates like a monitor for a user while the user is browsing the web, and enables the user to obtain and interact with context-sensitive services and information based on the user's browsing activity. The system allows the user to add application tools, which are implemented on servers separate from the user's computer. Third parties can easily add tools to the system by registering application services with the system.

In appellant's words, Furst teaches a method and system for providing adjunct functionality to a web browser by running applications at a remote server as opposed to within the browser itself. These applications run as part of the web browser operation, and are dependent on the site currently being accessed by the user's web browser.

More specifically, a program is downloaded and installed on a user's computer (col. 4, lines 42-46, all column and line references are to the Furst patent). This program is coupled to the user's web browser application (col. 5, lines 12-20). Windows or icons (e.g., Fig. 5, elements 502 – 508) are rendered for the operation of "application-specific services" related to the user's interactions with the web browser, those application-specific services operating on core servers (col. 2, lines 13-22). Furst states that "The core functionality is provided by one or more servers...and a client program

running on the user's computer that interacts with the user's running web browser..." (col. 2, lines 13-17, emphasis added) and furthermore that "The client 124 is essentially a thin shell for an embedded web browser, whose function is to display web pages sent by the System or by component application tools" (col. 4, lines 63-65, emphasis added). Several important distinctions now become apparent, particularly with reference to claim 51.

B. *Furst fails to teach retrieving instructions which display content independent of a web browser program*

First, while the present retrieves instructions "specifically designed to display certain Internet content independent of a web browser program" (claim 51, line 5-7), Furst discloses a system which is dependent upon and connected, visually and logically, to a web browser. Not only does Furst fail to expressly teach retrieving information comprising instructions for presenting a frame specifically designed to display Internet content independent of a web browser program, it actually teaches a dependence on a web browser, as demonstrated for example by the portions of the reference cited in the preceding paragraph, as well as:

- In the Abstract (at line 2-3) "a browser-aware application delivery system"

- In the Summary (at col. 1, lines 20-21) "receives information about what the user is doing on the web from the user's web browser"; (at col. 2, line 29) "displayed by a web browser operating as a program embedded in the client"

- In the Detailed Description (at col. 4, lines 63-65) "The client 124 is essentially a thin shell for an embedded web browser, whose function is to display web pages sent by the System or by component application tools"; (at col. 5 lines 18-20) "when the user launches the web browser 122, the web browser causes the client 122 (sic) to be launched automatically"; and indeed (at col. 8, lines 16-17, emphasis added) the very sentence cited against the claims and referred to above begins "[a]s the user navigates the web using the web browser and the context changes..."

- In Fig. 4A in which the internet Explorer icon is shown in the upper right corner of the tool window 402, and Fig. 5 in which the tool icons are shown connected to and extending both without and within a traditional Internet Explorer browser window.

The pervasive dependence by the system of Furst on an internet browser application for content rendering cannot be selectively ignored in the process of rejecting applicants claims. Diamond v. Diehr, supra. This aspect of the invention is not merely an element of the specification, but a limitation in the independent claim 51. If the Examiner seeks to show that the claimed invention is taught by ignoring certain

elements of the cited reference (i.e., modifying the cited reference to remove dependence upon a running web browser application), the Examiner must identify, either in the reference or in the general knowledge in the art, and without reference to the claimed invention, demonstrable evidence for a suggestion to ignore those specific elements. "[T]he examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references ... in the manner claimed." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). This burden falls squarely on the Examiner in the first instance. Ex parte Levy, 17 U.S.P.Q.2d 1461 (BPAI 1990). Absent such a suggestion, all of the teachings of the reference must be considered as a whole, each integral to the operation of the teachings of the reference. And of course, for any rejection in which a reference must be modified in order to demonstrate a claim a rejection under 35 U.S.C. 103 is the appropriate basis, as opposed to the rejection under 35 U.S.C. 102 applied in the present case. Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131.

By providing a mechanism for the delivery of information for rendering web content independent of a web browser, the present invention overcomes a fundamental hurdle in enabling improved content development and delivery as well as ease of access and use of such content. Prior efforts to deliver web content have, like Furst, been constrained, logically and visually, by the limited design freedom, code overhead,

performance delays, and other disadvantages necessitated by dependence on a conventional web browser application.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros., supra. As Furst fails to teach a critical limitation found in claim 51, namely the step of retrieving "instructions usable by the computing device to present a frame, with associated controls, specifically designed to display certain Internet content independent of a web browser program," by law Furst cannot anticipate claim 51 under 35 U.S.C. 102.

Since each of claims 52-56 depend directly or indirectly from claim 51, and therefore contain all limitations found in that base claim, they must contain the aforementioned limitation relating to the retrieval of instructions fir displaying content independent of a web browser. As Furst fails to teach such a limitation, that reference also fails to anticipate claims 52-56 under 35 U.S.C. 102. Verdegaal Bros., supra.

C. *Furst fails to teach providing content addresses in response to a user request*

Second, the present invention provides to a user's computing device instructions together with an address from which content may be retrieved for display. The instructions and address are retrieved in response to a user's request therefor.

However, there is no teaching in Furst of providing content addresses in response to a user request. Rather, Furst obtains the address of desired content directly from the user (not in response to a user's request). For example, Furst states that "as the user is browsing the web, the client listens to the browsing requests made by the user" (col. 5, lines 42-44), and then initiates the application on the server if one of a set of URLs is observed.

Contrary to the assertion in the Office Action regarding col. 7, line 8 through col. 8 line 4, col. 9, lines 40-47, and col. 10, lines 37-41, Furst does not provide the information for rendering the display together with an address for content to be rendered therein. In some applications, such as that referred to in the cited col. 10, lines 37-41, the application tool may obtain URLs from past user activity, such a browsing history or designated "favorite" URLs, but these URLs are not provided together with Furst's application when the application is downloaded (i.e., Furst does not teach "in response to the request, retrieving information comprising: instructions...and an address"). (Claim 51, lines 5-8.) Furst depends upon the user activity, as opposed to the frame designer's specification, in order to determine the address of content to be retrieved. Furst's dependence prevents a content provider from simply developing an appropriate or otherwise preferred or customized frame for its content, then providing that frame and an address for the content in a convenient, bundled package. And it prevents a user from simply obtaining such a package and simply causing the information obtained to

render a frame and populate it with the appropriate content. The present invention, as claimed, address these very shortcomings.

In other words, Furst fails to teach "in response to the request, retrieving information comprising: instructions...and an address from which said certain web content can be retrieved" (claim 51, line 8). As Furst fails to teach this critical limitation found in claim 51, Furst cannot anticipate claim 51 under 35 U.S.C. 102. Verdegaal Bros., supra.

And again, since each of claims 52-56 depend directly or indirectly from claim 51, they contain all limitations found in that base claim. As Furst fails to teach the limitation of "in response to the request, retrieving... an address from which said certain web content can be retrieved" (claim 51, line 8), Furst must also fails to anticipate claims 52-56 under 35 U.S.C. 102. Verdegaal Bros., supra.

D. *Furst fails to teach retrieving instructions for rendering a frame and invoking a process which is resident on the user's computing device when invoked, the results of which being capable of display within the frame*

With regard to claims 42 and 56, appellant next asserts that Furst fails to teach retrieving a program which runs on the user's computer, the results of which are displayed in the frame. Critically, the key point of Furst is the running of a remote

applications operable with the user's browser. The thrust of Furst is the provision of functionality typically provided by "plug-ins" (local applications running as part of a browser program) instead by applications operating at remote servers. Rather that a process running locally the results of which being displayed in the frame, Frust teaches running a process remotely and displaying the results thereof in the frame.

According to Furst, all applications operate at remote servers ("a client program...interacts with the ...core servers" col 2, lines 14-17, and "All data is stored on database servers. Only HTML cookies are placed on the user's computer." Col. 5, lines 33-35.) Through its stated dependence on servers, Furst expressly precludes operating applications on the user's computer. This dependence on servers increases the complexity and latency of the running applications, a problem which is addressed by the present invention.

Rather than separate the process and the display of data by running processes at remote servers, the present invention ties together the running of a process and a frame specific to that process for displaying the results thereof, to enable a user to run various functionality locally and have the display of those processes by within frames associated with the processes. As Furst is silent about obtaining a frame definition and instructions invoking a process to run locally, then displaying the results of that process in the defined frame, it does not teach each and every limitation found in claims 52 and 56. Accordingly, Furst cannot anticipate claims 52 and 56 under 35 U.S.C. 102 (Verdegaal Bros., supra.)

9. Summary and Conclusion

In summary, the applied reference fails to teach each limitation found in the rejected claims 51-56. Specifically, Furst's shortfalls are its dependence on a running web browser application and it running applications remotely. These aspects of Furst render it impossible for Furst to teach:

(a) retrieving information including instructions usable by the computing device to present a frame, with associated controls, specifically designed to display certain Internet content independent of a web browser program;

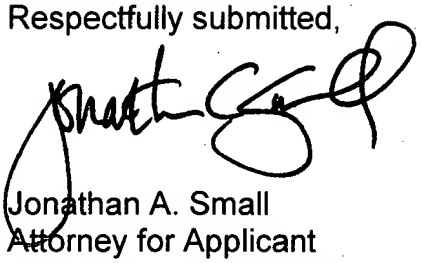
(b) retrieving such information together with an address from which said certain web content can be retrieved; and

(c) retrieving such information including instructions for invoking a first process, resident on said computing device when invoked, the results of which being capable of display within the frame.

Based on the fact that there is at least one limitation in each rejected claim not found in the Furst reference, Furst cannot form a basis for rejection of those claims under 35 U.S.C. 102.

Accordingly, applicant requests that the Board reverse the rejections of all claims, with remand to pass this application to allowance.

Respectfully submitted,



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APPENDIX 1 – Appealed Claims

51. In a server system, a method of providing Internet content to a user of a computing device, comprising:

receiving a request from a computing device;

in response to the request, retrieving information comprising:

instructions usable by the computing device to present a frame, with associated controls, specifically designed to display certain Internet content independent of a web browser program; and

an address from which said certain web content can be retrieved; and

transmitting the information to the computing device.

52. The method of claim 51, wherein at least a portion of the information further comprises instructions for invoking a first process, resident on said computing device when invoked, the results of which being capable of display within the frame.

53. The method of claim 51, wherein at least a portion of the information defines a functionality and an appearance of the frame within which said certain web content may be presented.

54. The method of claim 51, wherein the frame is one of a family of such frames, the family having certain common features and certain unique features, and the information further comprises those features unique to the frame.

55. The method of claim 54, wherein the information further comprises instructions for creating an instance of the common features within and associated with the frame.

56. The method of claim 54, wherein each member of the family of such frames has associated therewith certain functionality, and wherein the information further comprises instructions usable by the computing device to invoke a second process capable of coordinating the functionality of the frames.

APPENDIX 2 – Evidence of Record

No additional evidence is being submitted with this appeal.

APPENDIX 3 – Related Proceedings

This application is involved in no other proceedings related to this appeal.